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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,936	03/11/2004	Sandeep Gupta	Q80456	4210

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EXAMINER

RAO, DEEPAK R

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,936

Applicant(s)

GUPTA ET AL.

Examiner

Deepak Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 ~~8~~ are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 and 9 ~~8~~ are allowed.
- 6) ☒ Claim(s) 1,2,4,7,8 and 10-14 ~~8~~ are rejected.
- 7) ☒ Claim(s) 3 and 5 ~~8~~ are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 031104, 061804, 09.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claims 1-14 are pending in this application.

Changes made by Certificate of Correction

Applicant has not provided the changes made to U.S. Patent No. 6,355,799 by Certificate of Correction. Applicant is hereby requested to submit the changes, see MPEP § 1411.01[R-2].

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

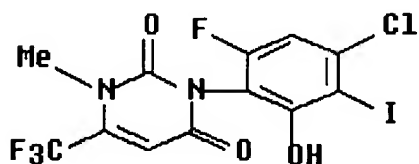
1. Claims 1, 4 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Crawford et al., U.S. Patent No. 6,077,812 (effective filing date February 26, 1997). The instant claims read on reference disclosed compound, 3-(4-chloro-6-fluoro-2-hydroxy-3iodophenyl)-1-methyl-6-

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trifluoromethyl-2,4(1H,3H)-pyrimidinedione (col. 13, lines 59-60). (The structural formula is depicted below for convenience).

RN 212755-11-8

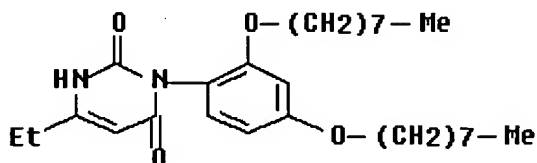
2,4(1H,3H)-Pyrimidinedione, 3-(4-chloro-6-fluoro-2-hydroxy-3-iodophenyl)-1-methyl-6-(trifluoromethyl)-



2. Claims 1 and 7 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 9-315006 (published December 9, 1997). The instant claims read on reference disclosed compound, see the compound (RN 201208-43-7) in the enclosed copy of CAPLUS Abstract 128:108494 (compound structure depicted below for convenience):

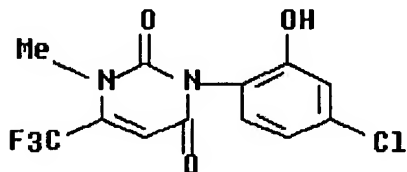
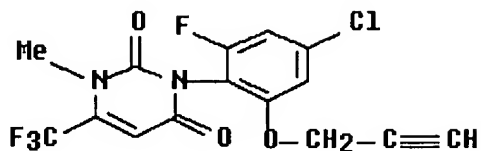
RN 201208-43-7

2,4(1H,3H)-Pyrimidinedione, 3-[2,4-bis(octyloxy)phenyl]-6-ethyl-

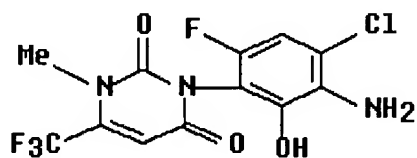


3. Claims 1, 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyazaki et al., WO 97/29105 (published August 14, 1997). The instant claims read on reference disclosed compounds, see the structural formulae (A-1) and (A-2) in page 30 and the corresponding species in pages 50-53 (representative examples of the compounds are depicted below):

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4. Claims 1, 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Crawford et al., WO 97/08170 (published March 6, 1997). The instant claims read on reference disclosed compound, see the structural formula M-1 in page 15 and the corresponding species in page 51, lines 11-12 (structural formula of the compound depicted below for convenience):



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 4, 7, 8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/09319. The reference teaches substituted uracil compounds that are structurally analogous to instantly claimed compounds. See the structural formula (I) and the corresponding compounds disclosed in pages 23-25, particularly compound no. 9. The compounds are taught to be useful as herbicides, see the abstract. The instant compounds differ from the reference compounds by having $-NR_4R_5$ at a different position of the phenyl ring as compared to the reference compounds, i.e., at the 2-position as compared to the 3-position. Therefore, the instantly claimed compounds are positional isomers of the reference compounds. It would have been obvious to one having ordinary skill in the art at the time of the invention to prepare the instantly claimed compounds because they are positional isomers of the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such isomeric compounds are suggestive of one another and would be expected to share similar properties and therefore, the same use as taught for the reference compounds, i.e., as pharmaceutical agents. It has been held that a compound, which is structurally isomeric with a compound of prior art is prima facie obvious absent unexpected

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results. *In re Finley*, 81 USPQ 383 (CCPA 1949); *In re Norris*, 84 USPQ 458 (CCPA 1950); *In re Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (Fed. Cir. 1990).

Allowable Subject Matter

Claims 6 and 9 are allowed. Claims 3 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Receipt is acknowledged of the Information Disclosure Statements filed on March 11, June 18 and September 13, 2004 and copies are enclosed herewith.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (571) 262-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Deepak Rao
Primary Examiner
Art Unit 1624

March 15, 2005